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REMARKS

Claims 1-20 are pending. Claims 15-20 stand rejected under 35 USC § 101, claims 1, 2, 6, 7, and 9 stand rejected under 35 USC § 102(e), and claims 3-5, 8, 10-16, and 17-20 stand rejected under 35 USC § 103(a). Claims 21-24 are new and do not add new matter. Applicant appreciates the interview to clarify the rejections with respect to the claims and the claims although no agreement was reached. Applicant respectfully traverses the rejections with respect to the claims 1-20 and new claims 21-24 with the following remarks.

Applicant requests interview

Applicant respectfully requests an interview if it would expedite disposition of the application. The undersigned attorney would welcome and encourage a telephone conference with Examiner at (512) 391-4913.

Rejections under 35 USC § 101

Claims 15-20 stand rejected under 35 USC § 101 as being non-statutory subject matter. Applicant amended claims 15-20 to clearly describe statutory subject matter. Thus, Applicant respectfully requests that the rejections be withdrawn.

Rejections under 35 USC § 102(e)

Claims 1, 2, 6, 7, and 9 stand rejected under 35 USC § 102(e) as being anticipated by Jorapur U.S. Pat. App. 2003/0204784 (hereinafter "Jorapur"). Applicant respectfully traverses the rejections with the following remarks.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single reference.[1] Furthermore, the identical invention must be shown in as complete detail as is contained in the claim.[2]

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[1] *Verdegaal Bros. v. Union Oil Co. of California,* 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987).

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Independent Claim 1

The Office action fails to establish a prima facie case of anticipation for amended independent claim 1 because Jorapur fails to describe, either expressly or inherently, "each and every element as set forth in the claim". In particular, Jorapur fails to describe:

> …machine-rendering a source code skeleton in response to a selection of the code segment within the source file, wherein machine-rendering comprises choosing additional code from the source file, outside of the selection, to include in the source code skeleton to supplement the code segment for compilation….

Jorapur describes "[a] system and method [to] provide testing of software in different configurations automatically."[3] Jorapur states that "[t]esting may check that an application complies with one or more specification…."[4] "Software may be tested at least in part automatically and testing may use automatically generated test cases. Test cases may be generated from one or more original tests…."[5] Jorapur also describes automating production of an application or applications by using standard templates or generating application templates "from parameters 201 provided by a user, an application, or default settings."[6] Jaropur describes a template generator "to generate an application template automatically."[7] In Jaropur, the templates "may include code for catching exceptions, passing values, and/or for standard functions."[8]

> Some templates may be used for a plurality of different types of software while others may be tailored for a specific type of software. For example, a template may be provided for an EJB configured to provide generic database access for a variety of other modules and another template may be provided for an EJB configured to process results from a particular web page.[9]

> In one embodiment, developers may produce code for modules or applications without using templates. Developers may update templates 200 or create new templates 200, for example from the code of developed modules or applications.[10]

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[2] *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).
[3] Jorapur Abstract, 1st sent.
[4] Jorapur par. 21, 2nd sent.
[5] Jaropur par. 22, 1st and 2nd sent.
[6] Jaropur pars. 25 and 26.
[7] Jaropur par. 27, 1st sent.
[8] Jaropur par. 27.
[9] Jaropur par. 27.
[10] Jaropur par. 29, 2nd and 3rd to last sent.

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The Office action predicates the rejection of claim 1 on the equivalence of a template and the source code skeleton. However, machine-rendering the source code skeleton in accordance with amended claim 1 involves "choosing additional code from the source file, outside of the selection, to include in the source code skeleton to supplement the code segment for compilation [in response to a selection of the code segment within the source file]...." Jaropur does not "machine-render[] the source code skeleton ... [by] choosing additional code from the source file, outside of the selection, to include in the source code skeleton to supplement the code segment for compilation [in response to a selection of the code segment within the source file]...." Jorapur generates application templates "from parameters 201 provided by a user, an application, or default settings."[11] Thus, Jaropur does not anticipate amended claim 1. Applicant respectfully traverses this rejection of claim 1 and requests that claim 1 be allowed.

Claims dependent upon claim 1 incorporate the limitations of claim 1 so claims 2-8 and new claims 21-22 include the limitations of claim 1. Thus, Applicant traverses rejections of claims 2-8 and 21-22 and requests that claims 2-8 and 21-22 be allowed.

Independent Claim 9

The Office action fails to establish a prima facie case of anticipation for amended independent claim 9 because Jorapur fails to describe, either expressly or inherently, "each and every element as set forth in the claim". In particular, Jorapur fails to describe:

> ...a file creator to machine-render a source code skeleton to create a temporary source file in response to a selection of the code segment, the file creator to machine-render the source code skeleton with additional code from the source file, outside of the selection, the file creator to choose the additional code from the source file based upon the code segment to supplement the code segment for compilation....

As discussed above, Jorapur describes automating production of an application or applications by using standard templates or generating application templates "from parameters 201 provided by a user, an application, or default settings."[12] And the Office action similarly predicates the rejection of claim 9 on the equivalence of a template and the source code skeleton.

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[11] Jaropur pars. 25 and 26.
[12] Jaropur pars. 25 and 26.

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However, the file creator to machine-render the source code skeleton in accordance with amended claim 9 is a "...file creator to machine-render the source code skeleton with additional code from the source file, outside of the selection, the file creator to choose the additional code from the source file based upon the code segment to supplement the code segment for compilation...." Jaropur does not "machine-render the source code skeleton with additional code from the source file, outside of the selection" and Jaropur does not "choose the additional code from the source file based upon the code segment to supplement the code segment for compilation...." Jaropur generates application templates "from parameters 201 provided by a user, an application, or default settings."[13] Thus, Jaropur does not anticipate amended claim 9. Applicant respectfully traverses this rejection of claim 9 and requests that claim 9 be allowed.

Claims dependent upon claim 9 incorporate the limitations of claim 9 so claims 10-14 and new claims 23-24 include the limitations of claim 9. Thus, Applicant traverses rejections of claims 10-14 and 23-24 and requests that these claims be allowed.

<p style="text-align:center">Independent Claim 15</p>

With regards to Jorapur, the Office action fails to establish a prima facie case of anticipation for amended independent claim 15 because Jorapur fails to describe, either expressly or inherently, "each and every element as set forth in the claim". In particular, Jorapur fails to describe:

> ...machine-rendering a source code skeleton in response to a selection of a code segment within a source file, wherein machine-rendering comprises incorporating additional code other than the code segment from the source file into the source code skeleton....

As discussed above, Jorapur describes automating production of an application or applications by using standard templates or generating application templates "from parameters 201 provided by a user, an application, or default settings."[14] And the Office action similarly predicates the rejection of claim 15 on the equivalence of a template and the source code skeleton. However, machine-rendering the source code skeleton in accordance with amended

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[13] Jaropur pars. 25 and 26.
[14] Jaropur pars. 25 and 26.

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claim 15 involves "incorporating additional code other than the code segment from the source file into the source code skeleton [in response to selection of the code segment]...." Jaropur does not "incorporat[] additional code other than the code segment from the source file into the source code skeleton [in response to selection of the code segment]...." Jorapur generates application templates "from parameters 201 provided by a user, an application, or default settings."[15] Thus, Jaropur does not anticipate amended claim 15. Applicant respectfully traverses this rejection of claim 15 and requests that claim 15 be allowed.

Claims dependent upon claim 15 incorporate the limitations of claim 15 so claims 16-20 include the limitations of claim 15. Thus, Applicant traverses rejections of claims 16-20 and requests that these claims be allowed.

Claim rejections under 35 USC § 103(a)

The Office action rejected claim 8 under 35 USC § 103(a) as being unpatentable over Jorapur in view of Friedman et al., U.S. Pat. 7,171,588 (hereinafter referred to as "Friedman"). The Office action rejected claims 10, 11, and 17 under 35 USC § 103(a) as being unpatentable over Jorapur in view of Gallardo ("Getting Started with the Eclipse Platform" from IBM on Nov. 1, 2002). The Office action further rejected claims 3-5, 13, and 14 under 35 USC § 103(a) as being unpatentable over Jorapur in view of Partamian et al., U.S. Pat. 7,062,755 (hereinafter referred to as "Partamian"). The Office action rejected claims 18 and 19 under 35 USC § 103(a) as being unpatentable over Jorapur in view of Gertz et al., U.S. Pat. App. 20040003335 (hereinafter referred to as "Gertz"). The Office action rejected claims 12 and 20 under 35 USC § 103(a) as being unpatentable over Jorapur in view of Melamed et al., U.S. Pat. App. 20040107415 (hereinafter referred to as "Melamed"). And, the Office action rejected claims 15 and 16 under the same rationale as claims 1-11.

To establish a prima facie case of obviousness, the modification or combination must teach or suggest all of Applicants' claim limitations.[16]

With regards to the rejection of claims 15 and 16, the rejections are predicated upon the anticipation of independent claims 1-11 by Jorapur. Applicant respectfully traverses the

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[15] Jaropur pars. 25 and 26.
[16] *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).

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rejection of the independent claim 1 above, showing that the independent claim is not anticipated by Jorapur. Thus, Applicant traverses this rejection also. Applicant respectfully requests that the rejections of claim 15 and 16 be withdrawn and that claims 15 and 16 be allowed.

Claims 3-5, 8, 10-14, and 16-20 are dependent upon independent claims 1, 9, and 15. Applicant respectfully traverses the rejections of the independent claims, showing that the independent claims are not anticipated by Jorapur. Because the 35 USC § 103(a) rejections are predicated upon anticipation of the limitations of claims 1, 9, and 15, Applicant traverses these rejections also. Thus, Applicant respectfully requests that the rejections of the dependent claims be withdrawn and that the claims be allowed.

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CONCLUSION

Applicant respectfully traverses the claim rejections under 35 USC §§ 102 and 103. Accordingly, Applicant believes that this response constitutes a complete response to each of the issues raised in the Office action. In light of the amendments made herein and the accompanying remarks, Applicant believes that the pending claims are in condition for allowance. Thus, Applicant requests that the rejections be withdrawn, pending claims be allowed, and application advance toward issuance. If the Examiner does not believe that the claims are in condition for allowance or would like to discuss the basis for the drawing amendments in further detail, the undersigned attorney requests a telephone conference at (512) 391-4913.

A petition for an extension and authorization for the corresponding fees accompany this response. No other fees are believed due with this paper. However, if any fee is determined to be required, the Office is authorized to charge Deposit Account 09-0447 for any such required fee.

Respectfully submitted,

October 18, 2007
_____
Date

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_____
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